REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 3, 2004, the Examiner rejected claims 10 and 18 under 35 U.S.C. §112, first paragraph, and rejected claims 10-16 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Kolling et al (United States Patent No. 5,920,847, hereinafter "Kolling"), in view of Thomson et al (United States Patent No. 4,948,174, hereinafter "Thomson"), in view of Anderson et al (United States Patent No. 6,058,380, hereinafter "Anderson"), in view of Heindel et al (United States Patent No. 6,304,857, hereinafter "Heindel"), in further view of Abe (United States Patent No. 6,501,557, hereinafter "Abe"), and rejected claims 17 and 21 under 35 U.S.C. §103(a) as being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, and further in view of Ferguson et al (United States Patent No. 6,336,094, hereinafter "Ferguson"). Applicant expresses appreciation for the recent Examiner's Interview and respectfully provides the following, which was the substance of the Examiner's Interview.

Rejection under 35 U.S.C. §112

In the Office Action, the Examiner rejected claims 10 and 18 under 35 U.S.C. §112, first paragraph, indicating that "the term 'dynamic' does not appear to be used per se in applicant's originally filed specification." Applicant respectfully submits that the amendments provided herein remove use of the term "dynamic," and thus overcome all rejections made by the Examiner under 35 U.S.C. §112, first paragraph.

Rejection under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 10-16 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, in further view of Abe, and rejected claims 17 and 21 under 35 U.S.C. §103(a) as

being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, and further in view of Ferguson. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings since the references teach away from the invention as claimed. For example, Kolling teaches of a "payment network" that is specifically defined as one where "... participating consumers pay bills to participating billers using a bill payment network ...". (Col. 11, lines 5-9) In the payment network, "... billers are universally identified and ... all participants agree to a set of protocols." (Col. 11, lines 9-10) In contrast, the references teach away. In contrast, the independent claims include limitations relating to generating and transmitting payment print data using any electronic accounting application at the customer computer system for payment of the amount owed to the vendor, regardless of whether the vendor utilizes electronic payment technology. Accordingly, Applicant respectfully submits that Kolling teaches away from the present invention as claimed.

In addition, Thompson teaches a process whereby the <u>vendor</u> prepares and provides the check to the customer in the same document as the invoice. (See Fig. 1a and Col. 6, lines 41-68).

In contrast, the independent claims include limitations relating to generating and transmitting payment print data using the electronic accounting application at the customer computer system for payment of the invoice received from the vendor, regardless of whether the vendor utilizes electronic payment technology. Accordingly, Applicant respectfully submits that Thomson teaches away from the present invention as claimed.

Accordingly, Applicant respectfully submits that no prima facie case of obviousness is established as there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings since the references teach away from the invention as claimed. And, as provided above, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Such teaching or suggestion to make the claimed combination and the reasonable expectation of success are not found in the prior art, and thus Applicant respectfully submits that the cited references do not make obvious the claims as provided herein.

In addition, Applicant respectfully submits that the references cited by the Examiner do not make obvious the claims provided herein as the cited references do not teach or suggest the limitations claimed in the present invention. In particular, the independent claims as provided herein include limitations relating to a method for using an electronic payment processing module coupled to any local electronic accounting application to effectuate payment of an invoice received from a vendor, regardless of whether the vendor or a financial institution of the vendor employs electronic data exchange for payment processing, the method comprising: providing a customer computer system having any electronic accounting application and the electronic payment processing module; generating and transmitting payment print data using the

electronic accounting application at the customer computer system for payment of the invoice received from the vendor, regardless of whether the vendor utilizes electronic payment technology; automatically receiving, at the electronic payment processing module, the transmitted payment print data from the electronic accounting application, wherein the electronic payment processing module is a print data reader and includes a check printing module and an electronic payment processing module; preprocessing the transmitted payment print data at the electronic payment processing module and automatically determining at the electronic payment processing module a manner of effectuating the payment of the invoice to the vendor, wherein the preprocessing includes searching for data patterns in the transmitted payment print data; if it is determined at the electronic payment processing module that the manner of effectuating the payment includes an electronic payment file, effectuating the payment by performing steps of: using the electronic print data to selectively generate an electronic payment file at the electronic payment processing module; transmitting the electronic payment file to a third-party electronic payment processing system to effectuate the payment of the amount owed by the customer to the vendor by one of: using an electronic payment technology to effectuate the payment when electronic payment exchange is utilized by at least one of (i) the vendor and (ii) the financial institution of the vendor; and generating and providing a printed negotiable instrument on behalf of the user to effectuate the payment when electronic payment exchange is not utilized.

These limitations are supported by the disclosure as originally filed. For example, reference is made to pages 8-13 and Figure 1 of the present application as originally filed. And, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations. For example, none of the references, alone or in combination, teaches or suggests generating and transmitting payment print data using any electronic accounting application at the

customer computer system for payment of the amount owed to the vendor, regardless of whether the vendor utilizes electronic payment technology; receiving the transmitted payment print data at a print data reader of the customer computer system, wherein the print data reader includes a check printing module and an electronic payment processing module; and preprocessing the transmitted payment print data at the print data reader and determining at the print data reader a manner of effectuating the payment to the vendor, wherein the preprocessing includes searching for data patterns in the transmitted payment print data.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations of the independent claims. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the independent claims nor the corresponding dependent claims, which depend from the independent claims.
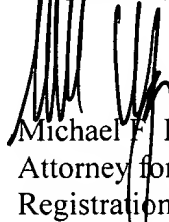
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein is not made obvious by the cited references and overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this **30** day of March, 2005.

Respectfully submitted,

Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

DBT:lc

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